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# In the Supreme Court of the United States

OCTOBER TERM, 1947

No. 515

JOHN D. PEDERSEN, PETITIONER

*v.*

THE UNITED STATES

*ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS*

## BRIEF FOR THE UNITED STATES IN OPPOSITION

### OPINION BELOW

The opinion of the Court of Claims (R. 104–113) is not yet officially reported.

### JURISDICTION

The judgment of the Court of Claims was entered on October 6, 1947 (R. 114). The petition for a writ of certiorari was filed on January 5, 1948. The jurisdiction of this Court is invoked under Section 3 (b) of the Act of February 13, 1925, as amended by the Act of May 22, 1939.

### QUESTIONS PRESENTED

The United States contracted with petitioner for the design of a semiautomatic shoulder arm.

Among other things, the contract provided that patents on all inventions made during the design and construction of the semiautomatic rifle would be the property of petitioner, that the United States would have an exclusive license to the use of these inventions, and that the exclusive license would permit the United States to manufacture "this arm" upon payment of a royalty of $1.25 per gun up to a maximum of 400,000 guns. The questions presented are:

1. Whether the contract obligates the United States to pay petitioner royalties for the manufacture of a semiautomatic rifle, not developed by petitioner and differing from petitioner's design in appearance, structure, and operation, because some features were within the terminology of certain invalid claims of petitioner's patents.

2. Whether there is substantial evidence to support the findings of the Court of Claims that the claims of petitioner's patents alleged to have been infringed either did not involve invention over the prior art or were not infringed.

## STATEMENT

Petitioner, a gun designer, brought two suits in the Court of Claims, which were subsequently consolidated, based upon the alleged use by the United States of petitioner's patents in the manufacture of the M–1 or Garand .30 cal. semiautomatic rifle (R. 1, 11, 104). Petitioner sought to recover royalties under a contract and compensa-

tion for the unauthorized use of his patented inventions after cancellation of the contract (R. 29). Holding that most of petitioner's claims did not involve invention and that the others were not infringed, the court below denied any recovery (R. 104).

The special findings of fact of the Court of Claims (R. 30–104) may be summarized as follows:

On May 21, 1923, petitioner entered into a contract with the United States for the development of a semiautomatic rifle (R. 32). The contract provided, among other things, that petitioner would disclose the work he had already done toward inventing and designing a semiautomatic gun and for one year from June 1, 1923, would "actively engage in the completion of the design and invention of this arm" (R. 33). Petitioner was to receive compensation in the amount of $10,000 for the year and was to retain ownership of any patents upon inventions disclosed or made in connection with the development of the semiautomatic rifle (R. 33–34). The United States was to receive an exclusive license to manufacture "this arm" upon payment of a royalty of $1.25 per gun up to a maximum of 400,000 guns (R. 34). Thereafter, the United States was to have a nonexclusive license to manufacture without payment of royalties (R. 34–35). The Government had the right to renew the license annually and an election to continue the license was to be implied unless

the Government gave notice of termination (R. 35). It was also agreed that the name "Pedersen" would appear on each arm manufactured by the United States under this agreement (R. 35). Similar contracts were made each successive year and the final contract was entered January 3, 1930 (R. 36).[1] This contract recited that a semiautomatic shoulder arm delivered under the contract of June 1, 1925, and 20 delivered under the contract of June 1, 1927, had passed several tests. It also recited that the construction of an improved arm embodying certain necessary or desirable changes in the type already delivered had been begun under the 1927 contract and continued under successive contracts but had not yet been completed (R. 37). The 1930 contract provided that petitioner would complete the design and building of the improved arm not later than December 31, 1930 (R. 38). The provisions of the contract with respect to patents, licenses, and royalties remained the same as in the earlier contracts (R. 38–39).

During the period when petitioner was developing and perfecting his semiautomatic rifle, the Ordnance Department was also developing and testing a semiautomatic rifle which was being designed by John C. Garand, a civilian employee

[1] In April 1928 the contract then in effect was cancelled by mutual agreement to enable petitioner to go to England in connection with some design work (R. 36). He returned after several months and the contracts were renewed (R. 36).

at the Ordnance Department, and another semiautomatic rifle designed by Brigadier General John T. Thompson (Fdg. 12, R. 41). Both of these semiautomatic rifles as first designed were charged with five .30 calibre cartridges from the standard stripping clip (R. 42). The Pedersen rifle was loaded with ten .276 calibre cartridges by an "*en bloc*" clip (R. 41, 42). During this period of development, the Garand, Thompson, and Pedersen rifles were subjected to comparative firing tests by the Ordnance Department (R. 42). As early as June 1926, a comparative report of the three rifles was made by the Infantry Board at Fort Benning, Georgia, and improvements were recommended with respect to each (R. 42–43). Another comparative report was made in February 1928, and a final report on the Pedersen rifle in May 1928 recommended its adoption with modifications (R. 44–46).

During the progress of the development work, petitioner filed applications which matured into patents entitled "Magazine Rifle," "Cartridge Clip," and "Combination of Cartridge Clip and Follower," the three patents on which these suits are based (R. 46–47). The "Magazine Rifle" patent relates to a mechanism for the release of the empty cartridge clip and its automatic ejection after the last cartridge has been fired and to a bolt lock mechanism which holds the breech bolt in a rearward position after the last cartridge has been fired and the cartridge clip ejected (R. 47).

The "Cartridge Clip" patent describes an *en bloc* cartridge clip for holding a double row of cartridges in staggered relationship (R. 47). The "Combination of Cartridge Clip and Follower" also discloses an *en bloc* cartridge clip holding a double row of cartridges with the addition of a follower designed to provide a self-adjusting step for supporting the staggered rows of cartridges regardless of whether the bottom cartridge in the clip is in the right or left row (R. 47).

Sometime prior to 1938 the United States began the manufacture of a semiautomatic rifle known as the M–1 or Garand rifle and *en bloc* cartridge clips for it (R. 47). The Garand rifle incorporated a mechanism for automatically ejecting the empty clip after the firing of the last cartridge and for locking the bolt in the rearward or open position (R. 48). This rifle also used an *en bloc* clip which held two rows of cartridges in staggered relationship (R. 48). In letters of October 20, 1938, and February 21, 1939, to the Chief of Ordnance, petitioner claimed that the Garand rifle contained features covered by his patents and requested the payment of royalties under the contract of January 3, 1930 (R. 48). By letter dated April 20, 1939, the Chief of Ordnance terminated the license agreement effective June 30, 1939 (R. 49). In response to a subsequent letter, the Chief of Ordnance advised petitioners that vouchers for guns manufactured through June 30, 1939, would be submitted to the General Accounting Office for

direct settlement but that the submission of vouchers was not "to be construed as an acknowledgment of the validity of your patents" (R. 49–50). The vouchers did not indicate on their face the approval of the Ordnance Department (R. 50). On January 10, 1940, the Comptroller General refused payment of the vouchers on the ground that the contract provided for the payment of royalties only if the semiautomatic rifle designed and developed by petitioner was manufactured by the United States, and that the Garand rifle and not that designed by petitioner had been adopted by the United States Army as standard equipment (R. 50–52). Petitioner thereafter brought one suit for breach of the patent license contract (R. 11) and another for compensation for the unauthorized use of his patents (R. 1).

The court below found that the Garand rifle was not the gun developed by petitioner (R. 103–104) and differed radically from it in many respects. See note 2, *infra,* pp. 16–17. Petitioner based his right to compensation in both suits on the ground that the Garand rifle embodied claims under the three patents previously mentioned. The claims asserted under the three patents, which are twenty in number, are discussed in detail in the findings. This summary statement will not deal individually with each of the claims but only with the principal features of the three patents and the related findings of the court below.

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The principal features of the "Magazine Rifle" patent which are in issue are a bolt stop for holding the bolt in its rearward position after the firing of the last cartridge, a latch for retaining the cartridge clip in position, and mechanisms for releasing and ejecting the empty cartridge clip (R. 52). Similar features occur in the Garand rifle (R. 61–62). Although the preferred embodiment of the Pedersen rifle disclosed in the specification is a gun of the semiautomatic type which employs an *en bloc* clip holding two rows of cartridges in staggered relationship, the claims in suit are couched in broad phraseology and do not specifiy any particular type of gun or cartridge clip and do not include any timing release of the clip other than to indicate that it is controlled by the exhaustion of cartridges in the clip (R. 65). The claims with respect to "automatic operation" (R. 57–58) merely refer to the automatic discharge of the cartridge clip upon the exhaustion of cartridges in the clip and the rearward positioning of the bolt (R. 65).

More than two years prior to the filing of petitioner's application there were available in the art eight United States patents, two German patents and two British patents (R. 63). Among these the Von Frommer (British) patent (R. 65) discloses a rifle in which the clip discharge mechanism is self-acting or automatic in operation and is controlled by the exhaustion of cartridges in the clip and by a subsequent positioning of the

breech bolt rearwardly (R. 67). Similar claims of petitioner's rifle patent are, therefore, anticipated by the Von Frommer disclosure (R. 67). The Gundlach (German) patent (R. 67) discloses a gun having a breech action comprising a reciprocating bolt and magazine chamber containing a clip of cartridges, a clip discharge mechanism tending to discharge said clip, a latch for restraining the discharge of said clip, and a cartridge feeding means which, upon exhaustion of cartridges in the clip, acts to release the latch and to permit the discharge of the clip by the clip discharge mechanism (R. 68). Comparable claims of petitioner are thus anticipated by the Gundlach patent (R. 68). The Von Wehrstedt (United States) patent (R. 68) discloses a breech loading magazine gun having a reciprocating breech bolt, a magazine chamber which is adapted to contain a clip of cartridges, a latch for retaining the clip in position, a clip discharge mechanism tending to discharge the clip, and a follower mechanism operating to feed the cartridges from the clip (R. 70). The clip discharge mechanism is arranged to discharge automatically the clip upwardly out of the magazine chamber and past the breech action upon retraction of the breech bolt after the last shot is fired, and is controlled by the exhaustion of cartridges in the clip and by the subsequent positioning of the bolt rearwardly in the receiver (R. 70). Thus numerous of petitioner's claims are also anticipated by the

Von Wehrstedt disclosure (R. 70). The Lantz (United States) patent (R. 70) discloses a gun having a bolt movable back and forth, a bolt stop operable for holding the bolt in its rear position, a clip of cartridges, a latch for retaining the clip of cartridges in position for loading, and a cartridge feeding means mounted on the gun independently of the clip (R. 74). The cartridge feeding means acts upon the exhaustion of cartridges in the clip to release the latch and also to actuate the bolt stop into its bolt holding position (R. 74). Petitioner's bolt stop claims are thus anticipated by the Lantz patent and do not present any patentable novelty over the prior art (R. 74). All of petitioner's claims under his rifle patent are therefore anticipated in the Von Frommer, Gundlach, Von Wehrstedt, and Lantz patents, and are void of patentable novelty (R. 76).

The "Cartridge Clip" patent comprises a U-shaped sheet metal clip constructed to hold a stack of cartridges in a tight compact package, the clip being adapted to be loaded into the magazine of the gun together with the cartridges (R. 76). The patent emphasizes as an important feature of novelty that the stack of cartridges contained in the clip is in a double row and that the clip is so constructed that it will hold the cartridge securely and in fixed relationship under all usual conditions of handling (R. 76). The clip is described as made of sheet metal or stamp-

ing possessing the requisite degree of strength, springiness, and lightness to accomplish the purpose for which it is designed (R. 77). Other than this the specification does not contain any specific instructions as to the thickness and kind of material of which the clip is to be made (R. 77). The clip disclosed in the patent is nonreversible in character, having a definite top and bottom which renders it capable of being introduced in the gun only in the one position (R. 77). It comprises a back and two sides designed to exert a lateral pressure on the cartridges in the clip (R. 77–78).

The alleged infringing structure used in the Garand rifle is a U-shaped clip made of sheet metal having a back wall and two forewardly extending sides (R. 80). When loaded it contains a stack of cartridges arranged in two rows in staggered relationship (R. 80). The Garand clip differs from that disclosed in petitioner's patent in that, being entirely symmetrical in structure, it is reversible, so that it may be inserted in the magazine chamber of the gun without respect to which is the top or bottom (R. 80), and may be loaded with a double staggered row of cartridges without particular attention to which side contains the high row (R. 81).

Although two of petitioner's claims under his cartridge clip patent were held not applicable to the Garand clip, the remaining claims were held applicable (R. 81–82). In connection with the

applicable claims, fifteen United States patents, one British patent, and one Swiss patent were available to those skilled in the art more than two years prior to the filing of petitioner's patent application (R. 82–83). The prior art disclosed in these patents reveals that the basic idea of packaging cartridges in sheet metal clips or containers adaptable for insertion into a rifle is relatively old (R. 83). Thirteen patents issued from 1888 to 1911 relate to the subject of cartridge clips (R. 83). Four of these disclose cartridge clips or packages which contain two rows of cartridges in staggered relationship (R. 83). Several prior patents disclose U-shaped sheet metal clips and cartridge retaining ribs (R. 84–86). Other patents also disclose a detachable magazine containing two rows of cartridges in staggered relationship or an integral one-piece *en bloc* cartridge clip for holding a stack of cartridges in a double row in mutually engaged relationship (R. 86–92). For example, the Mondragon (United States) patent discloses a reversible type integral one-piece *en bloc* cartridge clip constructed for the purpose of containing a stack of cartridges in a double row which resembles the Garand clip in that it is symmetrical in form and may be loaded with either row high (R. 89). The Frey (Swiss) patent also discloses a reversible *en bloc* cartridge clip for holding a stack of cartridges in a double row which is similar to the Garand clip in that it is symmetri-

cal in form and is capable of being loaded with either row high (R. 90). In connection with the prior art disclosures in other patents, all of the infringed claims under petitioner's clip patent are anticipated by the Frey disclosure and are invalid for anticipation and lack of invention (R. 92).

Petitioner's "Combination of Cartridge Clip and Follower" patent disclosed a reversible cartridge clip and a cooperating follower (R. 93). The clip, which held a double-row stack of cartridges in staggered relation, was symmetrical so that either side might be charged into the magazine (R. 94). The follower, which supported and fed the cartridges through the magazine, contained a step which shifted automatically as necessary to a right or left-hand position, so that the follower would accommodate the staggered cartridges in the clip, supporting both rows, regardless of which side was low (R. 94). Petitioner's claims related principally to this feature of the patent (R. 96–97). The Garand reversible clip is also used in connection with a follower which employs a different mechanism from petitioner's to support the low row of cartridges in the staggered arrangement regardless of whether it is on the right or left side; the evidence is in conflict as to whether or not a shifting element or slide in the Garand follower also supports the high row (R. 98).

Five United States and one Swiss patent were available in the prior art more than two years prior to petitioner's application for the clip and follower patent (R. 98–99). The Lewis (United States) patent (R. 99) discloses a follower mounted on springs which is sufficiently flexible to permit it to be tilted automatically to engage the bottom cartridge in the clip whether it be on the right or left side (R. 100). The Mondragon (United States) patent (R. 101) discloses a follower which does not shift but which, by means of two symmetrical grooves at the top of the follower, engages the bottom cartridge of the two staggered rows regardless of which side is low (R. 102). Although neither of these patents discloses a shifting support for the upper row of cartridges, the Mondragon clip and follower, with the mere mechanical addition of the Lewis shifting element to support the upper row of cartridges, anticipates all the claims of petitioner's clip and follower patent (Fdg. 75, R. 102–103).

To summarize, Garand or M–1 rifles which used *en bloc* clips were manufactured by or for the United States before the termination of its contract with petitioner effective June 30, 1939. Although these Garand rifles and clips come within the terminology of certain claims of two of petitioner's three patents, the Garand rifle is not the gun developed by petitioner within the meaning of his contract with the United States (Fdg. 78,

R. 103–104). Moreover, all the claims of the rifle patent alleged to be infringed are invalid. All but two of the claims of the clip patent alleged to be infringed are invalid. One of these two is not infringed and the other, if interpreted broadly enough to be infringed, is invalid. All the claims of the clip and follower patent alleged to be infringed are invalid. (Fdg. 79, R. 104.)

On the foregoing findings of fact the Court of Claims concluded as a matter of law that petitioner was not entitled to recover and dismissed the suits (R. 104). The court interpreted the contract as one calling for the payment of a specified royalty only if the Army manufactured a gun developed by petitioner and not a rifle developed by someone else, differing in appearance, construction, and operation from petitioner's, but which incorporated some features old in the art upon which petitioner held invalid patents (R. 108–109). No validly patented detail of petitioner's rifle was found to be infringed by the Garand rifle (R. 113).

## ARGUMENT

The interpretation of the contract provisions as obligating the United States to pay royalties, in addition to annual compensation of $10,000, only if petitioner's gun was adopted or, at most, only if the gun adopted incorporated valid patents of petitioner, seems wholly consonant with the terms of the agreement. It does not appear that peti-

tioner contends otherwise. Although petitioner urges that the court misconstrued the contract, the alleged error appears to be based on the assumption that some of his inventions were used and that the court required that all be used (Pet. 12). As we have seen, the court found that none of the claims of petitioner's patents that appeared in the Garand rifle involved valid invention. The court's further conclusion that the Garand rifle was not petitioner's design is best supported by its own description of the differences between the two guns (R. 107–108).[2]

[2] "We have said that the plaintiff's claim in the royalty contract case that the Garand rifle is in fact the Pedersen rifle is apparently based upon the incorporation in the Garand rifle of devices upon which the plaintiff claims he holds patents. It is probably true that the plaintiff would have been entitled to royalties under his contract if the Government had copied his rifle, even though his rifle had involved no inventions, or, if it did, he had taken out no patents upon them. But in appearance at least, and in the large working parts of the two guns, there is little resemblance, almost as little as there could be between two semiautomatic shoulder rifles. Perhaps the first thing to be decided in the design of a semiautomatic weapon is how to obtain the power to operate the mechanism. Pedersen obtained his power from the rearward push of the cartridge case when the power exploded. In his gun patent he said that one advantage of this was that it saved the weight and bulk of a tube slung under the barrel to carry force from the compression in the barrel between the cartridge case and the bullet. Yet Garand used the tube device, with its added weight and bulk, after having worked, in earlier models, with a third method, that of taking power from the explosion of the primer. Both

Since petitioner nowhere specifically asserts a right to recover regardless of invention, the only issue which appears to be presented is that of the validity of petitioner's patents. This is traditionally a question of fact. *United States* v. *Esnault-Pelterie,* 303 U. S. 26, 29; *United States* v. *Esnault-Pelterie,* 299 U. S. 201, 205. The court below in 79 special findings (R. 29–104) has closely scrutinized petitioner's patents, the claims under

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Pedersen's method and that of Garand were old in the art, but they were completely different from each other, and each required different designing of other parts of the gun to cooperate with the method used. An apparent instance is the fact that Pedersen's bolt could not be positively locked in position to hold the cartridge in the chamber, since it had to be free to yield to the rearward motion of the cartridge case as the bullet left it, while Garand's bolt is positively so locked, and is only set free by a turning motion produced by the gas pressure created by the bullet the instant before it leaves the barrel. The Pedersen bolt works on a toggle which throws it almost vertical when it is in its rearward position. The Garand bolt slides straight back. The Pedersen bolt remains locked back when a clip of cartridges is exhausted and until a new clip is completely inserted, and then is released only by a separate manual pull backward. The Garand bolt is released as the inserted clip reaches its final position and is latched in and the operator's thumb is pushed aside forcefully by the return of the bolt to its closed position. The Pedersen gun has an extensive covering of metal meshing around the barrel to cool it. The Garand gun has no such device.

"The two guns are generally speaking not alike then, in either appearance, construction or operation, except in those particulars in which any two semiautomatic shoulder rifles would, it would seem, have to be alike. * * *" (R. 107–108).

them, the alleged infringements, and the patents in the prior art. These claims and their relation to prior inventions are specifically discussed with meticulous care. The studied analysis of the court below clearly supports its ultimate finding that all claims involving infringement lack invention over the prior art. It is well settled that in the absence of a conflict of decision, the issue of invention does not present a question for review by this Court. *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314; *Layne & Co.* v. *Western Well Works*, 261 U. S. 387; *General Pictures Co.* v. *Electric Co.*, 304 U. S. 175, 178–179. There are no circumstances in this case which would warrant a departure from that rule.

## CONCLUSION

The judgment of the court below is clearly correct and there is no conflict of decisions. The petition for a writ of certiorari should, therefore, be denied.

Respectfully submitted.

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MARCH 1948.

U. S. GOVERNMENT PRINTING OFFICE: 1948